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EXAMINER

LUKS, JEREMY AUSTIN

ART UNIT

PAPER NUMBER

2832

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/578,764             | NAKAMURA, SHOICHI   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | JEREMY LUKS            | 2832                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-12 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Embodiment 2, claims 1-12 in the reply filed on 7/13/09 is acknowledged.

### ***Double Patenting***

2. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 11. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "said apparatus" in line 11. There is insufficient antecedent basis for this limitation in the claim.
4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 requires a sub-head portion having spaces for receiving a sub-diaphragm and mounting means for mounting said sub-diaphragm or said apparatus. According to this requirement, the stethoscope will always have a sub-

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diaphragm regardless of whether the mounting means is for mounting the sub-diaphragm or a different apparatus. When reading the Specification, it appears that the sub-head portion of the stethoscope head has either a sub-diaphragm or an apparatus with the corresponding mounting means, however the claim allows for the sub-diaphragm and apparatus to both be present in the same embodiment. Further, it is unclear what is meant by the phrase "a detachable elastic member fitted *in and* outer circumferential edge defined by said sub-head portion," in claim 2. Still further, it is unclear what is meant by the phrase "wherein said main head portion and said sub-head portion are constructed such that..." in claim 9

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 7-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Rossini (5,945,640) in view of Moore (5,252,787).

With respect to Claim 1, Rossini teaches a stethoscope head (Figures 2-4) comprising a head main body portion (11) and a conduit connecting portion (area near #32, 33) provided on said head main body portion (11), said head main body portion (11) including a main head portion (22) and a sub-head portion (23) made of any conventional material such as ceramic metal or plastic (Col. 4, Lines 33-38) and a

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conduit connecting port (area near #32, 33) positioned between the main head portion (22) and the sub head portion (23), said main head portion (22) including a main diaphragm (34) formed from epoxy resin, or other conventional materials (Col. 7, Lines 13-24) connected to said conduit connecting port (area near #32, 33), said sub-head portion (23) being provided with spaces for receiving a sub-diaphragm (34B) for high frequency stethoscope use or narrow zone stethoscope use or various functions (Col. 4, Line 63 – Col. 5, Lines 7); and mounting means (35B/39B) for mounting said sub-diaphragm (34B) on said sub-head (23) portion. Rossini fails to explicitly teach wherein the head main body portions and the main diaphragm are transparent or semitransparent, and wherein the mounting means is for mounting an apparatus. However, the Examiner considers it to be obvious that the metal, ceramic or plastic material used to make the head main body portion, and the epoxy resin material used to make the diaphragms will exhibit a transparent or semitransparent appearance because they are the same materials that Applicant's invention uses. Further, It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide head main body portions and the main diaphragm that are transparent or semitransparent, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Still further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moore teaches wherein it is

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known to incorporate a sub-head portion (Figures 1-5, #30) having mounting means (30/38) for mounting an apparatus (32) on the sub-head portion (30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Rossini, with the apparatus of Moore to provide allow for a user to observe a patient's heart rate over a period of time in order to calculate the number of heart beats per minute, wherein the stethoscope and timekeeping watch element can be viewed simultaneously.

With respect to Claim 2, Rossini teaches wherein said mounting means (35B/39B) has a detachable elastic member (39) fitted in and outer circumferential edge (area near 41B) defined by of-said sub-head portion (23).

With respect to Claim 3, Rossini teaches a washer member (could 35B) mounted on the outer circumferential edge (area near 41B) of the sub-head portion (23) by the elastic ring member (39B) to retain the diaphragm (34B) within the spaces. Moore teaches a similar snap-fit configuration (Col. 2, Lines 33-50) for retaining an apparatus (32) within the spaces.

With respect to Claim 7, Rossini teaches wherein said main head portion (22) and said sub-head portions (23) are formed from at least one of metal, acryl resin or glass (Col. 4, Lines 33-38).

With respect to Claim 8, Rossini teaches wherein said main diaphragm (34) is formed from a transparent or semitransparent epoxy resin or nylon (Col. 7, Lines 13-24). Further, It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide head main body portions and the main diaphragm that

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are transparent or semitransparent, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

With respect to Claim 9, Rossini teaches wherein said main head portion (22) and said sub-head portion (23) are constructed such that they are fitted each other by a fitting type fitting portion (11). The Examiner considers the one piece construction of head main body, having main and sub portion (22 and 23) to constitute a fitting type fitting portion.

With respect to Claim 10, Moore teaches wherein said apparatus (34) is a stop-watch, or a watch.

With respect to Claims 11 and 12, Rossini teaches wherein said stethoscope head (11) includes a conduit (12) for guiding a stethoscope sound connected to said stethoscope head (11), an ear pipe (14) connected to said conduit (12), and an ear tip (42) connected to said ear pipe (14).

### ***Allowable Subject Matter***

6. Claims 4-6 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The Examiner considers that the references of the Prior Art of record fail to

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teach, or suggest any obvious combination of the limitations of claim 1, and further comprising the limitations of **(With respect to claim 4)** wherein a mounting means comprises a rotatable cam connected to said apparatus, a driving portion to be moved in a horizontal direction by the cam, and an O-ring fitted in the outer circumferential portion of said driving portion, the cam being connected to said apparatus and being rotatable whereby a part of the outer circumferential portion of said driving portion is pressed against the inner wall of a space of the sub-head portion so that said apparatus is mounted on said sub-head portion.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent arts of record relating to stethoscope heads are disclosed in the PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Luks whose telephone number is (571) 272-2707. The examiner can normally be reached on Monday-Thursday 8:30-6:00, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy Luks/  
Examiner, Art Unit 2832

/Jeffrey Donels/  
Primary Examiner, Art Unit 2832